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JULY 16, 97

Paper No. 17

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Brian Moore Guitars, Inc.

Serial No. 74/455,676

Ronald S. Bienstock of Horing, Welikson & Bienstock, P.C.
for Brian Moore Guitars, Inc.

Andrew P. Baxley, Trademark Examining Attorney, Law Office
104 (Sidney I. Moskowitz, Managing Attorney).

Before Sams, Simms and Cissel, Administrative Trademark
Judges.

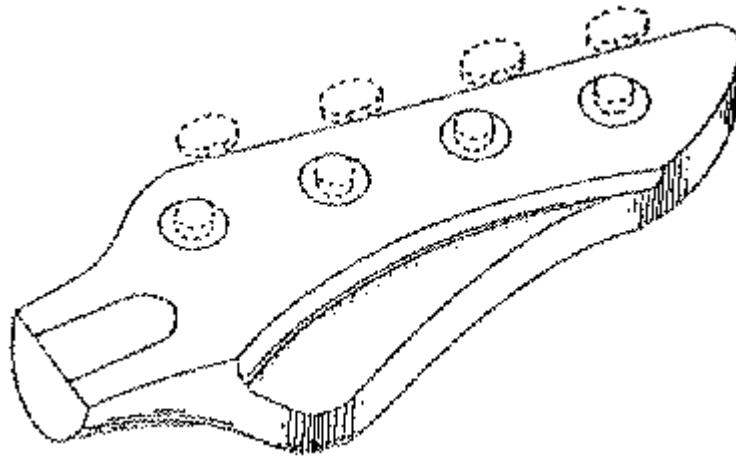
Opinion by Cissel, Administrative Trademark Judge:

On November 9, 1993, applicant applied to register the
configuration of the guitar headstock design shown below



for what were subsequently identified by amendment as "electric guitars and acoustic guitars and bass guitars and parts thereof." The application is based on a claim of use since October 1, 1993.

Registration was refused under Sections 1, 2 and 45 of the Act on the ground that the proposed mark is functional, and under Section 2(d) of the Act on the ground that the proposed mark so resembles the mark shown below,



which is registered¹ to Peavey Electronics Corporation for "musical instruments, namely, guitars," that confusion is likely.

Responsive to the refusal to register based on functionality, applicant did not deny that its headstock serves a utilitarian purpose, but argued that the design is not unregistrable under the Act. Applicant contended that the design is only de facto functional, rather than de jure functional, and argued that it is therefore entitled to

¹Reg. No. 1,738,262, issued on the Principal Register on December 8, 1992.

registration because it has acquired distinctiveness under Section 2(f) of the Act. Applicant also argued that confusion with the registered mark is not likely in view of the differences in the marks and the sophistication of the purchasers of the goods.

Attached to applicant's response were several exhibits, including reviews of applicant's guitars from 20th Century Guitar Magazine and Guitarist Magazine, an article about applicant's guitars from the Putnam Reporter Dispatch, and a promotional brochure for applicant's guitars.

The Examining Attorney was not persuaded by applicant's arguments and exhibits. He maintained the refusal to register based on the likelihood of confusion under Section 2(d) of the Act and he apparently withdrew the refusal under Sections 1, 2 and 45 of the Act based on functionality, agreeing with applicant that the design sought to be registered is only de facto functional. He held that applicant had not, however, established that the design has acquired distinctiveness under Section 2(f) of the Act.

Applicant responded with more argument and exhibits, including advertisements and photographs of applicant's guitars and the guitars of three competitors, Fender, Gibson and Washburn. Also submitted was another copy of the article about applicant's guitars from the Putnam Reporter Dispatch.

The Examining Attorney withdrew the refusal based on Section 2(d), but made final the refusal based on his

finding that applicant has not established that the design it seeks to register has acquired distinctiveness.

Applicant then filed a Notice of Appeal to the Board, followed by a request for reconsideration. The request provided dollar amounts for applicant's advertising expenditures from 1990 through July of 1995. Also included with the reconsideration request was a copy of a printed advertisement for applicant's guitars. The advertisement features ten photographs of guitar players and quotations from each regarding applicant's guitars, but the headstock design is neither mentioned in the quotations nor featured in the pictures. Applicant argued that the advertisement is "an example of acceptance and recognition in the marketplace."

The Examining Attorney remained unpersuaded by applicant's arguments, and the application was returned to the Board for resumption of action on the appeal. Applicant filed its brief, attaching a copy of an advertisement from a recent issue of Travel & Leisure Magazine. The advertisement is for the Disney Institute, which is described as a resort in Florida. On the second page it shows what appears to be the neck and headstock of one of applicant's guitars, along with a pair of drumsticks. Above the photo is an invitation to "Participate in an open rehearsal by your favorite guitarist."

The Examining Attorney filed his brief. In addition to making arguments in support of the refusal to register, he

specifically consented to the Board's consideration of the evidence applicant untimely filed with its brief. His position, however, is that the advertisement does not support the conclusion that the design has become distinctive of applicant's products.

No request for an oral hearing was made by applicant.

The legal principles governing this dispute are well settled and are not disputed by applicant or the Examining Attorney. "A design configuration is considered to be unregistrable when it has been determined to be de jure, as opposed to de facto, functional. An item which is de facto functional may be registrable, while one which is de jure functional may never be registered even if it has been shown to possess some recognition in the trade." In re Peters, 6 USPQ2d 1390, 1391 (TTAB 1988). In order to hold the design in question de jure functional, it must be shown not just that the item has a function, but also that the performance of that function is enhanced by the particular configuration in which the design is executed. In re R. M. Smith, 734 F.2d 1482, 222 USPQ 1 (Fed. Cir. 1984). A configuration which embodies a design which is so superior to other available designs for achieving its purpose is de jure functional, and it is not registrable on either register. In re Morton-Norwich Products, Inc., 671 F.2d 1332, 213 USPQ 9 (CCPA 1982). If, however, the design is a feature of the goods which is only one of many equally feasible, efficient and competitive alternatives, then it is considered to be

merely de facto functional and may be registered on the Supplemental Register or on the Principal Register if it is inherently distinctive or if it has acquired distinctiveness under Section 2(f) of the Act. In re R. M. Smith, Inc., supra.; In re Ovation Instruments, Inc., 201 USPQ 116, (TTAB 1968).

As noted above, the issue in this appeal is not whether the design sought to be registered is de jure functional. Contrary to the position taken in the Examining Attorney's appeal brief, whether or not the configuration is de facto functional is not an issue. De facto functionality is not a ground for refusal of registration. Indeed, it would be difficult to conceive of a product configuration which is not at least de facto functional.

Both applicant and the Examining Attorney agree that the design is de facto functional. Applicant does not contend that it is inherently distinctive. The issue, therefore, is whether or not applicant has established that the configuration of applicant's guitar headstock is registrable under Section 2(f) of the Act because it has acquired distinctiveness.

To establish secondary meaning, applicant must show that the primary significance of the design in the minds of the people who purchase guitars is not the product, but rather is an indication of the producer. Distinctiveness is typically established with evidence of how long the mark has been used, the type and amount of advertising of the mark,

and any other evidence that shows that the consuming public for the goods associates the proposed mark with a particular source. In re Pennzoil Products Company, 200 USPQ 753 (TTAB 1991).

Based on careful consideration of all of the exhibits submitted and arguments made by applicant, however, we agree with the Examining Attorney that applicant's design is not inherently distinctive, and that applicant has not met its burden of establishing that the configuration has developed secondary meaning as an indicator of the source of applicant's goods. We will discuss each group of evidentiary submissions in turn.

The first attempt to show acquired distinctiveness was the September 19, 1994 response to the first refusal. Exhibit A thereto is simply a copy of the drawing of applicant's guitar headstock. This has no probative value on the issue before us.

The second two exhibits are reviews of applicant's product from guitar magazines. The text of the first notes that the headstock on applicant's guitar is "a particularly well designed and attractive piece of work." The second reviewer notes that he likes the headstock design very much. Both reviews feature photos of applicant's guitars, but the configuration of the headstock is neither emphasized in the pictures nor mentioned further in the text. These two magazine articles are plainly favorable reviews of applicant's guitars, but neither indicates that either

applicant or the reviewer views the design of the configuration of the headstock as an indication of the source of the guitars.

Exhibit D is the article about applicant's business from The Putnam Reporter Dispatch. The caption beneath one photo therein notes that "Even the headstocks...on the custom instrument are unique." Near the end of the two-page text, a music store manager is quoted concerning the contoured back of the guitar. He goes on to add "And there's a really nice headstock." Although the headstocks are shown in the accompanying photos, both attached to the completed product and detached therefrom as unfinished components during the manufacturing process, no further attention is paid to the design of the headstock. We cannot conclude from these exhibits that the configuration of applicant's headstock serves as a trademark for these guitars.

The final exhibit to the first response to the refusal is a promotional brochure featuring text and photographs of applicant's guitars. Although the headstock design is shown on the cover and in several other pictures in the sixteen-page pamphlet, the only mention of it in the text is on the eighth page, wherein "Features" of the product are listed. These features include "Natural Wood Binding," "Advanced Neck-thru Composite Design," "Choice of Fingerboards" and "Distinctive Sculptured Headstock." This exhibit clearly

does not establish that the design sought to be registered has acquired distinctiveness.

The exhibits submitted with applicant's January 17, 1995 response to the second refusal to register are likewise unpersuasive that the design has acquired secondary meaning. The competitive guitars shown are not dramatically different in appearance from applicant's guitars. Applicant does not even mention its headstock design in the texts of either advertisement. The review of applicant's guitar in the guitar magazine does note that "...the headstock itself is a particularly well designed and attractive piece of work." Neither the ads nor the review, however, indicates that the design sought to be registered is perceived by guitar purchasers as an indication of the source of applicant's products.

The next exhibit submitted by applicant in support of the claim under Section 2(f) of the Act is the advertisement attached to the request for reconsideration. As mentioned above, the headstock is neither mentioned in the text nor featured in the photographs. The quotations may show that the musicians pictured in the advertisement are all pleased with applicant's product, but the ad is not evidence that the headstock design functions as a trademark for applicant's guitars.

The reconsideration request includes a statement that applicant spent almost \$350 thousand on advertising from 1992 through mid-1995, but this statement does not provide

us with a basis for concluding that the advertising featured the design sought to be registered, or that the amount spent on such advertising had the effect of creating recognition of the design as a trademark in the minds of prospective guitar buyers. We have no examples of the advertisements, nor do we have any information with which to put applicant's expenditures into perspective relative to the promotional expenses of applicant's competitors.

The exhibit submitted untimely with applicant's appeal brief, but nonetheless accepted by the Examining Attorney, is the ad for the Disney Institute. That another, unrelated business pictures the headstock in its own advertisement promoting its theme park does not establish that the admittedly de facto functional design has become distinctive as a source indicator for applicant's goods.

In summary, because applicant has not met its burden of proving that the configuration sought to be registered has come to be regarded as a trademark for applicant's goods, the refusal to register is affirmed, and registration to applicant is refused.

J. D. Sams

R. L. Simms

R. F. Cissel
Administrative Trademark Judges

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